

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	79142368
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 112
<b>MARK SECTION (no change)</b>	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_1-632344734-20150616140046478594 . OAR 79142368 WITTE SOLINGEN GERMANY Des</a>
<b>CONVERTED PDF FILE(S) (1 page)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\423\79142368\xml14\RFR0002.JPG</a>
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_1-632344734-20150616140046478594 . OAR 79142368 Consent to Register Agreement.pdf</a>
<b>CONVERTED PDF FILE(S) (4 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\423\79142368\xml14\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\423\79142368\xml14\RFR0004.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\423\79142368\xml14\RFR0005.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\423\79142368\xml14\RFR0006.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	Office action response and consent to register agreement
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/rhb/
<b>SIGNATORY'S NAME</b>	Roger H. Bora
<b>SIGNATORY'S POSITION</b>	Appointed U.S. Counsel, Ohio bar member

<b>SIGNATORY'S PHONE NUMBER</b>	937.443.6817
<b>DATE SIGNED</b>	06/16/2015
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Tue Jun 16 14:12:34 EDT 2015
<b>TEAS STAMP</b>	USPTO/RFR-63.234.47.34-20 150616141234072283-791423 68-530ce94bb277932b48ede3 67161dc8a4aa0f83d36af6374 3d19f1027d5a562caf4-N/A-N /A-20150616140046478594

PTO Form 1960 (Rev 9/2007)  
OMB No. 0651-0050 (Exp. 07/31/2017)

## Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **79142368** has been amended as follows:

### EVIDENCE

Evidence in the nature of Office action response and consent to register agreement has been attached.

#### Original PDF file:

[evi\\_1-632344734-20150616140046478594 . OAR 79142368 WITTE SOLINGEN GERMANY \\_Design.pdf](#)

#### Converted PDF file(s) ( 1 page)

[Evidence-1](#)

#### Original PDF file:

[evi\\_1-632344734-20150616140046478594 . OAR 79142368 Consent to Register Agreement.pdf](#)

#### Converted PDF file(s) ( 4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

### SIGNATURE(S)

**Request for Reconsideration Signature**

Signature: /rhb/ Date: 06/16/2015  
Signatory's Name: Roger H. Bora  
Signatory's Position: Appointed U.S. Counsel, Ohio bar member

Signatory's Phone Number: 937.443.6817

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79142368  
Internet Transmission Date: Tue Jun 16 14:12:34 EDT 2015  
TEAS Stamp: USPTO/RFR-63.234.47.34-20150616141234072  
283-79142368-530ce94bb277932b48ede367161  
dc8a4aa0f83d36af63743d19f1027d5a562caf4-  
N/A-N/A-20150616140046478594

Re: SN 79/142,368

This is in response to the Office action dated December 16, 2014, in which the Examining Attorney refused registration of Applicant's mark on the basis it is confusingly similar to the mark depicted in Reg. No. 0987576.

Based upon Applicant's arguments in the record and the submitted consent to register agreement executed by the cited registrant, Applicant respectfully requests that the Examining Attorney withdraw the refusal based upon Section 2(d) of the Act and approve its mark for publication in the *Official Gazette*.

Consent Agreement

Applicant submits herewith a consent agreement signed by the cited registrant (the "Consent Agreement"). The parties have investigated each other and have determined that confusion between their respective marks is unlikely for the reasons stated in the submitted Consent Agreement.

The Court of Appeals for the Federal Circuit has clearly indicated that a consent agreement between two parties is to be accorded great weight, and that the Office should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly indicate a finding of likelihood of confusion. *See Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 U.S.P.Q.2d 1305 (Fed. Cir. 1988).

In light of the submitted Consent Agreement, it is respectfully requested that the refusal to register Applicant's mark on the ground of likelihood of confusion with the cited mark be withdrawn.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of

Mark : W WITTE SOLINGEN GERMANY & Design  
Applicant : Kurt Reiner Witte GmbH & Co. KG  
Serial No. : 79142368  
Filed : November 18, 2013  
Attorney : Kamal Preet  
Law Office : 112

Atty. Docket : 075709.00042

Assistant Commissioner for Trademarks

Sir:

**CONSENT TO REGISTRATION**

This letter will confirm that Industrie- und Handelskammer Wuppertal-Solingen-Remscheid Corporation ("IK WSR"), a corporation of the Federal Republic of Germany, hereby consents to registration of the trademark W WITTE SOLINGEN GERMANY & Design ("Witte Mark"), the subject of the above-referenced United States trademark application Serial No. 79142368 ("Witte Application"), owned by Kurt Reiner Witte GmbH & Co. KG ("Witte"). As an officer of IK WSR, I am authorized to grant such consent on its behalf.

IK WSR owns U.S. certification mark Registration No. 0987576 for SOLINGEN ("IK WSR Mark"). It is our understanding that Reg. No. 0987576 has been cited against the Witte Application as a basis for refusal to register on the grounds of confusing similarity. It is our opinion that, given the quality level and price of the products sold under the Witte Mark, the sophistication of the relevant buyers of the goods of this nature, and the differences between the two marks, the Witte Mark is not confusingly similar to the IK WSR Mark. Further, although the IK WSR Mark, a certification mark, and the Witte Mark have been used in overlapping geographic territories for years, both nationally and internationally, IK WSR is not aware of any instances of actual confusion.

**A. Sophisticated Nature of Witte's Goods and Buyers of Witte's Goods.**

As stated in the Witte Application, we understand that Witte uses the Witte Mark in connection with a wide array of high-quality cutlery, including scissors, knives, and tweezers, as well as pet grooming products. Such high-quality cutlery is relatively costly, in comparison to average-quality cutlery. Witte's customers typically are professional stylists and pet groomers. Because of the relatively high cost associated with the products sold under the Witte Mark, such purchasers exercise a relatively high degree of care and consideration in making a purchasing decision.

The IK WSR Mark is likewise used for quality cutlery originating in the area of Solingen, Germany. The highly specialized products sold under the Witte Mark typically are sold to niche markets in which the product providers are well known to the purchasers of the products.

**B. Channels of Trade.**

Given the sophisticated nature of the products provided by Witte under the Witte Mark, Witte does not advertise its products over mass media, or provide its products through consumer-oriented retail outlets. Rather, Witte advertises in trade publications and uses direct marketing. Consequently, it is highly unlikely that in the marketplace, the Witte Mark would appear side by side, or in close physical proximity to a user of the IK WSR Mark.

**C. The IK WSR Mark and the Witte Mark are Distinguishable.**

The Witte Mark comprises a large letter "W" in which a pair of scissors forms the center portion, with the name WITTE in smaller letters immediately below it. In much smaller letters, the words SOLINGEN GERMANY appear below the name WITTE. This W symbol clearly is the dominant feature of the Witte Mark, and in combination with the name WITTE make up almost the entirety of the Witte Mark. The words SOLINGEN GERMANY make up a very minor component of the Witte Mark. Because the words SOLINGEN and GERMANY are of equal size and type font, the two words are taken together, and the clear import to a purchaser is

Ser. No. 79142368  
Atty. Docket No. 075709.00042  
Page 3

that they name the geographic location of the source of the cutlery products sold under the Witte Mark, rather than serve a trademark or certification mark significance.

In view of the foregoing, the Witte Mark is quite different in appearance from the IK WSR Mark, which is simply the word SOLINGEN.

**D. Both Witte and Users of the IK WSR Mark Operate in the Same Geographic Territory.**

Both Witte and the users of the IK WSR Mark use the two marks in connection with products in commerce with the United States which are produced according to the Solingen decree (German law gazette I 1994, p.3833). We are informed that Witte has been using the Witte Mark for many years in the United States, and the IK WSR Mark has been used by users in the United States since 1853. Despite the years of co-existence of the marks in the United States marketplace, we are not aware of any instances in which prospective purchasers of the products have mistaken Witte for a user of the IK WSR mark, and vice versa.

For the foregoing reasons, Industrie- und Handelskammer Wuppertal-Solingen-Remscheid Corporation ("IK WSR") hereby consents to the registration of the Witte Mark in the United States as per the Witte Application in relation to goods produced according to the Solingen decree (German law gazette 1994, p. 3833) and the Regulations of the Chamber of Industry and Commerce Wuppertal-Solingen-Remscheid for the Use of the Community Collective Mark "Solingen" of November 30<sup>th</sup> 2005 in the valid version.

Sincerely,

Industrie- und Handelskammer Wuppertal-Solingen-Remscheid Corporation

By: \_\_\_\_\_

Name: WENGE \_\_\_\_\_

Title: CEO \_\_\_\_\_

Ser. No. 79142368

Atty. Docket No. 075709.00042

Page 4

Date: June 3rd, 2015